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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,778	02/08/2002	Robert T. Woodburn III	RTW-2	2026

32842 7590 01/12/2005

THE LAW OFFICE OF JILL L. WOODBURN, L.L.C.  
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EXAMINER

NGUYEN, CAMTU TRAN

ART UNIT PAPER NUMBER

3743

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

### Period for Reply

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-15 is/are allowed.
- 6) ☒ Claim(s) 1 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 2-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is in response to applicant's amendment filed on December 9, 2004. Claims 1 and 13 have been amended. Claims 11, 12, and 19-24 have been cancelled. Applicant's comments pertaining to the Milligan reference are acknowledged. The claims, as amended, however, have been carefully considered and are rejected in view of newly discovered references for the reasons below.

### ***Claim Objections***

Claims 4 and 5 are objected to because currently these claims depend from themselves, respectively. It appears that applicant might have intended for them to depend from claim 2. For purposes of this Office Action, these claims are treated as if they had depended from claim 2.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 18 fails to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed February 8, 2002. In that paper, applicant has disclosed in the specification on page 4 line 32-34 to page 5 lines 1-2 stating the attachment portion (2) of fixation member (14) may be coupled to the mouthpiece member (12) using any number of commercially available adhesives

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or with heat welding, and this statement indicates that the invention is different from what is defined in the claim(s) because no where in the specification did applicant disclose the mouthpiece member and the mask are coupled together with an adhesive.

Accordingly, claim 18 is further rejected as best can be understood and interpreted below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Milligan (U.S. Patent No. 5,267,353). Milligan discloses in Figures 8-10 a protective face guard (80) comprising a mouthpad (120) to the face guard (80). The face guard (80) and the mouthpad (120) are coupled together with a mouth plastic sheet (122) and clamp brackets (124). With regards to claim 18, Milligan discloses mouthpad (120) is coupled to the face guard (80) via adhesive to the mouth plastic sheet (122) and secured by clamp brackets (124).

Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Milligan (U.S. Patent No. 5,267,353). Milligan discloses in Figures 8-10 a protective face guard (80) comprising a face guard (80) and a mouthpad (120). The mouth plastic sheet (122) coupled to the mouthpad (120) via adhesive and clamp brackets (124) formed to couple the faceguard (80) to the mouth plastic sheet (122) so that the mouthpad (120) is in a fixed position relative to the mask.

The introductory statement of intended use and all other functional statements have been carefully considered but deemed not to impose any structural limitations on the claims distinguished over the Milligan device in the sense of 35 USC 102 which is capable of being used as set forth in these claims.

### ***Allowable Subject Matter***

Claims 2-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 13-15 are allowed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Camtu T. Nguyen whose telephone number is 703-305-0537. The examiner can normally be reached on (M-F) 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Camtu Nguyen  
December 30, 2004



Henry Bennett  
Supervisory Patent Examiner  
Group 3700